

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOSEPH D. REVNELL

Appeal No. 2005-0057
Application No. 09/505,119

ON BRIEF



Before FRANKFORT, MCQUADE and BAHR, Administrative Patent Judges.
MCQUADE, Administrative Patent Judge.

ON REQUEST FOR REHEARING

Pursuant to 37 CFR § 41.52, the appellant, Joseph D. Revnell, requests rehearing (i.e., reconsideration) of our decision on appeal rendered February 18, 2005 to the extent that we sustained the following rejections made by the examiner:

- a) the 35 U.S.C. § 102(b) rejection of claim 69 as being anticipated by Martinez;
- b) the 35 U.S.C. § 103(a) rejection of claims 2 through 4, 7, 9, 11, 12, 14, 25, 54 through 56, 58, 60, 62, 63 and 65 as being unpatentable over Barker in view of Moxey;

- c) the 35 U.S.C. § 103(a) rejection of claim 5 as being unpatentable over Barker in view of Moxey and Rauch;
- d) the 35 U.S.C. § 103(a) rejection of claims 6, 13, 30, 32, 34, 36 through 38 and 64 as being unpatentable over Barker in view of Moxey and Trevino;
- e) the 35 U.S.C. § 103(a) rejection of claims 10 and 61 as being unpatentable over Barker in view of Moxey and Martinez;
- f) the 35 U.S.C. § 103(a) rejection of claims 15 and 66 as being unpatentable over Barker in view of Moxey and Mercier;
- g) the 35 U.S.C. § 103(a) rejection of claim 31 as being unpatentable over Barker in view of Moxey, Trevino and Rauch; and
- h) the 35 U.S.C. § 103(a) rejection of claim 35 as being unpatentable over Barker in view of Moxey, Trevino and Martinez.

In the decision (see page 18), we designated the above sustained rejections that rely on Barker, not all of which were argued in the main and reply briefs, as new grounds of rejection under 37 CFR § 41.50(b). In the request for rehearing, the appellant has taken advantage of the opportunity afforded by this designation to present arguments which had not been previously made. We have considered all of the arguments advanced in the request with the following results.

I. The 35 U.S.C. § 102(b) rejection of claim 69 as being anticipated by Martinez

The appellant continues to argue that Martinez does not meet the recitation in claim 69 of the step of "recording angle information for each distance recording signifying an angle of the tape relative to the stationary member." Such argument is no more persuasive now than it was before. According to the appellant, claim 69 requires two recording acts: one for distance and one for angle information. As pointed out in our decision (see pages 6 through 8), however, claim 69 does not actually call for two such acts. The teaching by Martinez of the accurate reading of distance and rotary position and the corresponding marking of same on sheet 44 relative to the center of the pivot hole 26 is fully responsive to the recording limitations which are recited in the claim.

Thus, on rehearing, the 35 U.S.C. § 102(b) rejection of claim 69 as being anticipated by Martinez is sustained.

II. The 35 U.S.C. § 103(a) rejection of claims 2 through 4,
7, 9, 11, 12, 14, 25, 54 through 56, 58, 60, 62, 63 and 65 as
being unpatentable over Barker in view of Moxey¹

With regard to independent claim 9, the appellant contends that Barker's lower arm 10, which corresponds to the stationary member recited in the claim (see page 10 in the decision), does not meet the recitation of a template formed by markings written directly onto the stationary member. Claim 9, however, does not recite the template as part of the claimed measuring and layout device. Instead, the language in the claim referring to the template merely sets forth an intended use of the stationary member. The appellant has not cogently explained, and it is not apparent, why Barker's stationary member (lower arm 10) is not inherently capable of being used in the manner specified to form a template. The appellant's additional (and repeated) argument that neither Barker nor Moxey discloses an angle and distance device fixedly and rotatably attached to a stationary member as recited in claim 9 is not persuasive for the reasons set forth in the decision (see page 10).

¹ The comments on page 7 of the request for rehearing indicate that the appellant is under the misapprehension, completely unsupported by the record, that we rejected these claims under 35 U.S.C. § 102(b) as being anticipated by Barker.

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Thus, on rehearing, the 35 U.S.C. § 103(a) rejection of claim 9 as being unpatentable over Barker in view of Moxey is sustained.

The appellant's contention that the combined teachings of Barker and Moxey would not have suggested a measuring and layout device comprising a stationary member having a circular configuration as recited in claim 11 or a semi-circular configuration as recited in claim 12 (and claims 2 through 4, 7 and 14 which depend from claim 12), or a method of measuring and laying out an area comprising the step of forming an accurate template by marking on the stationary member as recited in claim 25 (and claims 54 through 56, 58, 60, 62, 63 and 65 which depend from claim 25) is well taken.

Thus, on rehearing, the 35 U.S.C. § 103(a) rejection of claims 2 through 4, 7, 11, 12, 14, 25, 54 through 56, 58, 60, 62, 63 and 65 as being unpatentable over Barker in view of Moxey is not sustained.

III. The 35 U.S.C. § 103(a) rejection of claim 5 as being unpatentable over Barker in view of Moxey and Rauch

The examiner's application of Rauch does not cure the above noted deficiencies of Barker and Moxey with respect to claim 12 from which claim 5 depends.

Thus, on rehearing, the 35 U.S.C. § 103(a) rejection of claim 5 as being unpatentable over Barker in view of Moxey and Rauch is not sustained.

IV. The 35 U.S.C. § 103(a) rejection of claims 6, 13, 30, 32, 34, 36 through 38 and 64 as being unpatentable over Barker in view of Moxey and Trevino

The examiner's application of Trevino does not cure the above noted deficiencies of Barker and Moxey with respect to claim 12 from which claims 6 and 13 depend.

Thus, on rehearing, the 35 U.S.C. § 103(a) rejection of claims 6 and 13 as being unpatentable over Barker in view of Moxey and Trevino is not sustained.

The appellant's argument that the combined teachings of Barker, Moxey and Trevino would not have suggested a measuring and layout device comprising a carrier fixedly and rotatably attached to a stationary member and a tape extender for mechanically extending a tape as recited in independent claim 30 is not persuasive. As explained in the decision (see page 10), Barker discloses a carrier fixedly and rotatably attached to a stationary member. Trevino discloses a tape extender for mechanically extending a tape and teaches that this feature facilitates the use of the tape by an individual (see column 1,

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lines 15 through 62). This disclosure by Trevino would have provided the artisan with ample motivation or suggestion to provide the Barker layout device with a tape extender as recited in claim 30 (and claims 32 and 38 which depend from claim 30 and are not separately argued apart therefrom).

Thus, on rehearing, the 35 U.S.C. § 103(a) rejection of claims 30, 32 and 38 as being unpatentable over Barker in view of Moxey and Trevino is sustained.

Claim 34 depends from claim 30 and recites that the template set forth in the parent claim includes markings written directly onto the stationary member. As is the case with claim 9, claim 34 does not recite the template as part of the claimed measuring and layout device and instead refers to the template solely in terms of an intended use of the stationary member. The appellant has not cogently explained, and it is not apparent, why Barker's stationary member (lower arm 10) is not inherently capable of being used in the manner specified to form a template.

Thus, on rehearing, the 35 U.S.C. § 103(a) rejection of claims 34 as being unpatentable over Barker in view of Moxey and Trevino is sustained.

The appellant's arguments that the combined teachings of Barker, Moxey and Trevino would not have suggested a measuring

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and layout device comprising a stationary member having a circular configuration as recited in claim 36 or a semi-circular configuration as recited in claim 37, or a method of measuring and laying out an area as recited in claim 25 from which claim 64 depends are convincing.

Thus, on rehearing, the 35 U.S.C. § 103(a) rejection of claims 36, 37 and 64 as being unpatentable over Barker in view of Moxey and Trevino is not sustained.

V. The 35 U.S.C. § 103(a) rejection of claims 10 and 61 as being unpatentable over Barker in view of Moxey and Martinez

The appellant's contention that the combined teachings of Barker, Moxey and Martinez would not have suggested the subject matter recited in claims 10 and 61 due to their dependencies from claims 12 and 25, respectively, is persuasive.

Thus, on rehearing, the 35 U.S.C. § 103(a) rejection of claims 10 and 61 as being unpatentable over Barker in view of Moxey and Martinez is not sustained.

VI. The 35 U.S.C. § 103(a) rejection of claims 15 and 66 as being unpatentable over Barker in view of Moxey and Mercier

The appellant's position that the combined teachings of Barker, Moxey and Mercier would not have suggested the subject matter recited in claims 15 and 66 by virtue of their

dependencies from claims 12 and 25, respectively, is well founded.

Thus, on rehearing, the 35 U.S.C. § 103(a) rejection of claims 15 and 66 as being unpatentable over Barker in view of Moxey and Mercier is not sustained.

VII. The 35 U.S.C. § 103(a) rejection of claim 31 as being unpatentable over Barker in view of Moxey, Trevino and Rauch

The appellant's argument that the rejection of claim 31, which depends from claim 30, is flawed because the combined teachings of Barker, Moxey, Trevino and Rauch would not have suggested a measuring and layout device comprising a front leg having guides for the tape as recited in claim 31 is not persuasive. Rauch discloses a tape measuring device having a front leg in the form of bracket 11 and guides 20 for guiding the extension and retraction of the tape. Such disclosure would have provided the artisan with ample suggestion or motivation to provide the front leg (upper arm 11) of the Barker device with guides as recited in claim 31 for the self-evident advantage of controlling the extension and retraction of the tape.

Thus, on rehearing, the 35 U.S.C. § 103(a) rejection of claim 31 as being unpatentable over Barker in view of Moxey, Trevino and Rauch is sustained.

VIII. The 35 U.S.C. § 103(a) rejection of claim 35 as being unpatentable over Barker in view of Moxey, Trevino and Martinez

The appellant's contention that the rejection of claim 35, which depends from claim 30, is unsound because the combined teachings of Barker, Moxey, Trevino and Martinez would not have suggested a measuring and layout device meeting the template limitations in the claim is unpersuasive. Here again the language in the claim relating to the template is in terms of an intended use. The appellant has not cogently explained, and it is not apparent, why Barker's stationary member (lower arm 10) is not inherently capable of being used in the specified manner to form a template.

Thus, on rehearing, the 35 U.S.C. § 103(a) rejection of claim 35 as being unpatentable over Barker in view of Moxey, Trevino and Martinez is sustained.

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SUMMARY

Our earlier decision is modified to be consistent with the foregoing remarks. To summarize, the decision of the examiner to reject claims 2 through 18, 25, 30 through 67 and 69 is affirmed with respect to claims 9, 30 through 32, 34, 35, 38 and 69, and reversed with respect to claims 2 through 8, 10 through 18, 25, 33, 36, 37, 39 through 67.

MODIFIED

Charles E. Frankfort

CHARLES E. FRANKFORT)
Administrative Patent Judge)

John P. McQuade

JOHN P. MCQUADE)
Administrative Patent Judge)

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